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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,322	12/12/2003	Charles F. Harris JR.	HARRIS-2	1379
<div>7590 HUNTLEY, L.L.C. Donald W. Huntley 1105 N. Market Street P. O. Box 948 Wilmington, DE 19899-0948</div>				
EXAMINER				
LAVINDER, JACK W				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
09/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/734,322

**Applicant(s)**

HARRIS ET AL.

**Examiner**

Jack W. Lavinder

**Art Unit**

3677

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 5-10, 20-22, 28, 37, 38, 41-44 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-19, 23-27, 29-36, 39, 40, 45-47 and 49-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drafts/Person's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Numbering***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 56-60 have been renumbered 60-64.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 11-19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All of these claims refer to "said human body part", which infers that the claims are claiming a human body part. These claims are indefinite because a human or a human body part cannot be claimed in an article claim.

Applicant is advised if claims 56-59 are found to be allowable, re-numbered claims 60-64 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

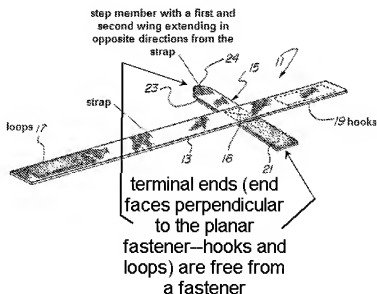
### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11-12, 14, 19, 23-27, 29-30, 32, 35 and 56-64 have been rejected under 35 U.S.C. 102(b) as being anticipated by Uso, Jr., 4759963. Uso, Jr. discloses a device capable of being used to dampen vibrations on a human body part (see annotated figure, column 2, lines 9-15). This strap is clearly capable of performing the function of applying no more than 5 pound-force on a human body part.



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 16-18, 31, 33 and 34 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Uso, Jr., 4759963.

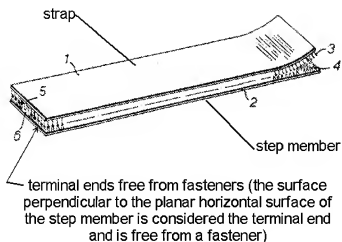
Regarding claims 13, 17, 18, 31, 33 and 34, Uso, Jr. discloses the strap being made from an elastic woven stretchable material. The claim requires that the material be selected from the group consisting of neoprene, polyethylene, polyurethane and spandex and that the material has a specific density, tensile strength, minimum elongation and compression deflection. The examiner takes official notice that all of these materials and properties are old and well known. Therefore, it would have been an obvious design choice to use any one of these materials to form the elastic portion of Uso, Jr.'s strap. The strap would function equally well with any of these type of elastomers. Furthermore, the specification fails to disclose any criticality by using these elastomers.

Regarding claim 16, Uso, Jr. discloses attaching the step member to the strap with stitching. It is old and well known that stitching and adhesive are design equivalents in fastening material. Therefore, it would have been an obvious design choice to use adhesive to attach Uso, Jr.'s step member to the strap. Either type of fastening means performs the same function equally as well as the other. Furthermore,

the specification fails to disclose any criticality with the use of adhesive to secure the strap to the step member over other fastening means.

Claims 1, 13, 15, 56-57 and 60-61 have been rejected under 35 U.S.C. 103(a) as being unpatentably over Smith, 3,403,429. Smith discloses a strap capable of dampening vibrations by wrapping around a human body part. The device includes a strap (1) and a step member (2), wherein the step member has a length longer than the width of the step member and the width of the strap. Smith also discloses that the two parts are made from a material known under the name "Velcro". It is well known that Velcro fastening straps are made from a plastic flexible material. Furthermore, neoprene, polyethylene, polyurethane and spandex are known materials. It would have been obvious to a person having ordinary skill in the art to use neoprene, polyethylene, polyurethane or spandex to form Smith's strap. The reason being that all of these materials perform the same function of providing a flexible strap equally as well as the other and the specification is absent any criticality as to why it is critical to use these materials in the strap.

Smith's strap is also capable of applying less than 5 pound-force to a human body part and has terminal ends on the step member that are free from a fastener (see the annotated drawing).



Claims 36, 39, 40, 45-47, and 49-55 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, Jr., 4628918 in view of Meyer, 2003/0045826.

Regarding claims 36, 39, 40, 45-47 and 49-55, Johnson, Jr. discloses a method for dampening vibration of soft tissue of a human wearer's body part comprising providing a stretchable strap with a step member with a first and second wing and wrapping the strap, under tension, around the body part. The claim also requires that the strap applies no more than 5 pounds-force on the human body part. Johnson, Jr.'s strap is capable of applying less than 5 pound-force on a human body part. Johnson fails to disclose the specifics regarding the amount of strap force/pressure being applied to the body part.

Meyer discloses that it is important to monitor the pressure being applied to the body part and that the pressure be applied within the range of 20 mmHg to 150mmHg, which converts to less than 3 psi.

Applicant's disclosure states that the pound-force on the strap be less than 5 pound-force, which converts to 32 psi on the body part. Meyer's range falls below that pressure and discloses the claimed limitation. It would have been obvious to monitor the pressure being applied by Johnson's device in order to facilitate the healing of the body part as taught by Meyer.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The declaration under 37 CFR 1.132 filed 2/25/2010 is insufficient to overcome the rejection of claims 1-4, 11-19, 23-27, 29-36, 39-40 and 45-47, 49-60 as set forth in the last Office action because: It includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack W. Lavinder whose telephone number is 571-272-7119. The examiner can normally be reached on Mon-Friday, 9-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571-272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jack W Lavinder/  
Primary Examiner, Art Unit 3677